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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,018	12/27/2001	Emile Di Serio	1759.066	9212

7590

11/02/2005

HESLIN ROTHENBERG FARLEY & MESITI, P.C.  
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Albany, NY 12203

EXAMINER
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LARSON, LOWELL A

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/035,018	SERIO, EMILE DI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lowell A. Larson	3725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 103***

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese 7-195136 (Mikito hereafter) taken with Baker et al. (newly cited) for the reasons set forth in Paragraph 2 of the prior Office action (paper mailed May 15, 2003).

Applicant's remarks in the response filed October 14, 2003 have been carefully considered but are not found to be persuasive. In particular, Applicant believes that Mikito does not disclose forging a perform which has been provided with recesses or cavities in a prior casting operation; cavities instead being formed in Mikito by "squeeze casting" in which pressure is applied to liquid metal in a casting die.

Applicant's analysis of Mikito is clearly erroneous. Mikito molding 50 of Figure 8 is a self-sustaining shape provided with cavities 51, 52 in a prior casting process, as explained in the Mikito discussion of Example 4. The self-sustaining shape 50 is further formed in die 61 by punch 62 into the final product 70 shown in Figure 9. Mikito further points out that during the further forming tools 63, 64 are inserted into preformed cavities 51, 52 in order to shape the holes 71 72 of the product. Mikito refers to die 61 as a **forging female mold** and to punch 62 as a **forging punch**, and also describes the process as a **forging forming cycle**.

In addition, Baker et al. discloses forming in which a metal workpiece is heated to a semisolid state and shaped in a die. In the Example discussed in column 5, the

semisolid slug shaped in such a manner is described as being "press forged". Thus it is seen that the further forming of the self-sustaining shape 50 in Mikito Figure 8 would be considered to be forging by one skilled in the art regardless of the fact that the pressing is performed while the work is in a semisolid state. Furthermore, Applicant has no disclosure of performing the forging of the invention under specific temperature or metallurgical conditions. Thus, the recitation of forging in this claim is not considered to distinguish over the further shaping of cast perform 50 in Mikito Figure 8 to obtain the product shown in Figure 9.

Since Baker et al. is relied upon merely to clarify the Mikito disclosure, this is not considered to be a new grounds of rejection.

***Claim Rejections - 35 USC § 102***

3. Claim 2 is again rejected under 35 U.S.C. 102(b) as being anticipated by Mikito for the reasons set forth in Paragraph 4 of the prior Office action.

Applicant's remarks in the response filed October 14, 2003 are not persuasive. Mikito refers to the punch and die 61, 62 of Figure 8 as forging dies. Furthermore, this claim is drawn to an apparatus. The conditions in which the apparatus is used is of no patentable consequence.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

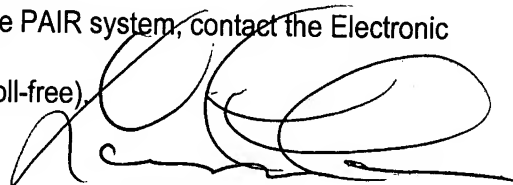
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lowell A. Larson whose telephone number is (571) 272-4519. The examiner can normally be reached from M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Banks Derris can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lowell A. Larson  
Primary Examiner  
Art Unit 3725

LAL